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10/712,353	11/14/2003	Benjamin H. Malka	05793.3114	1450
22852	7590	06/10/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3694	
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			06/10/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/712,353

**Applicant(s)**

MALKA ET AL.

**Examiner**

Ella Colbert

**Art Unit**

3694

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 12-16, 32-40, 43-47, 63-71 and 74-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-16, 32-40, 43-47, 63-71, and 74-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-9, 12-16, 32-40, 43-47, 63-71, and 74-78 are pending. Claims 1, 5, 16, 32, 34, 36, 37, 45-47, 63, 65, 67, 68, and 76-78 have been amended and claims 10, 41, and 72 have been cancelled in this communication filed 3/10/10 entered as Response After Non-Final Action and Request for Extension of Time.
2. The claim objections to claim 63 has been overcome by Applicants' amendment to claim 63 and is hereby withdrawn.
3. The 35 USC 112, Second Paragraph Rejections from the Office Action mailed 11/10/09 for claims 1-32 and 63 have been overcome by Applicants' amendments and cancellation of claims 10, 11, and 17-31 and are hereby withdrawn.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 32, and 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 as amended, recites "wherein the investment fund is configured to allow at least one of the plurality of investors to withdrawn from the financial investment fund at any time regardless of maturity dates of any of the plurality of certificates of deposit;". The recitation "allow" is not considered a positive recitation in the claim limitation. Suggestion: "wherein the investment fund is configured in which at least one of the plurality of investors can withdrawn from the

financial investment fund at any time regardless of maturity dates of any of the plurality of certificates of deposit;". Claims 32 and 53 as amended have a similar issue.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 32, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,297,026) Hoffman in view of (US 5,291,398) Hagan and further in view of Carll, Joseph M. –"Should Insurance Agents be offering CDs?", hereafter Carll

Claim 1. Hoffman discloses, A method, performed by a processor, associated with a financial institution, for funding the financial institution through a financial investment fund, the method comprising:  
receiving, by the processor (Fig. 3(62), a plurality of individual funds corresponding to a plurality of investors respectively (col. 2, lines 32-47 and col. 3, lines 1-25); aggregating, by the processor (Fig. 3(62), the plurality of individual funds into an aggregated fund for investing in the financial investment fund (col. 2, lines 57-68). Hoffman failed to disclose, determining, by the processor, a first portion of the financial investment fund to invest in a plurality of certificates of deposit issued by the financial institution, wherein the plurality of certificates of deposit mature at varying maturity dates by laddering

based on anticipated need for liquidity within the aggregated fund, wherein the first portion of the financial investment fund is used by the financial institution for providing cash to satisfy the anticipated need for liquidity, and wherein the financial investment fund is configured to allow at least one of the plurality of investors to withdraw from the financial investment fund at any time regardless of maturity dates of any of the plurality of certificates of deposit; and determining, by the processor, based on the amount of the first portion invested in the plurality of certificates of deposit, a second portion of the financial investment fund for investing in a transaction account, wherein the transaction account is used to fund a withdrawal from the financial investment fund by any investor among the plurality of investors. Hagan discloses, determining, by the processor, a first portion of the financial investment fund to invest in a plurality of certificates of deposit issued by the financial institution, wherein the plurality of certificates of deposit mature at varying maturity dates with a degree of laddering based on anticipated need for liquidity within the aggregated fund (Col. 1, line 42-col. 2, line 64 and col. 3, lines 41-55); and determining, by the processor, based on the amount of the first portion invested in the plurality of certificates of deposit, a second portion of the financial investment fund for investing in a transaction account, wherein the transaction account is used to fund a withdrawal from the financial investment fund by any investor among the plurality of investors (col. 6, line 15-col. 8, line 30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Hagan in Hoffman because such an incorporation would allow Hoffman to have the capability to periodically monitor accounts by focusing on the additions of

interest to all accounts and regarding certificates of deposit and the due dates of those CDs such that when a particular CD becomes due the principal is returned to the investment company.

Hagan failed to disclose, wherein the first portion of the financial investment fund is used by the financial institution for providing cash to satisfy the anticipated need for liquidity, and wherein the financial investment fund is configured to allow at least one of the plurality of investors to withdraw from the financial investment fund at any time regardless of maturity dates of any of the plurality of certificates of deposit. CarlI discloses wherein the first portion of the financial investment fund is used by the financial institution for providing cash to satisfy the anticipated need for liquidity, and wherein the financial investment fund is configured to allow at least one of the plurality of investors to withdraw from the financial investment fund at any time regardless of maturity dates of any of the plurality of certificates of deposit (page 4, para.'s. 6-7- "An advantage in purchasing a CD through a broker vs. a bank is the option to liquidate the investment before the maturity date without a preset penalty"). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of CarlI in Hoffman and Hagan because such an incorporation would allow Hoffman and Hagan to have the capability for one of the investors to withdraw from the financial investment fund regardless of the maturity dates of the certificates of deposit since the investor can liquidate the CDs before the maturity dates. Claim 32. Hoffman discloses, A system, including a processor associated with a financial institution, for funding the financial institution through a financial investment

fund, the system comprising: a component for receiving a plurality of individual funds corresponding to a plurality of investors respectively (col. 2, lines 32-47 and col. 3, lines 1-25); a component for aggregating the plurality of individual funds into an aggregated fund for investing into the financial investment fund, wherein the financial investment fund includes a plurality of certificates of deposits and a transaction account (col. 2, lines 57-68). This independent claim is rejected for the similar rationale as given above of claim 1.

Claim 63. Hoffman discloses, A computer-readable medium on which is stored a set of instructions for funding a financial institution through a financial investment fund, which when executed perform a method comprising: receiving a plurality of individual funds corresponding to a plurality of investors respectively (col. 2, lines 32-47 and col. 3, lines 1-25); and aggregating the plurality of individual funds into an aggregated fund for investing into the financial investment fund, wherein the financial investment fund includes a plurality, of certificates of deposits and a transaction account (col. 2, lines 57-68). This independent claim is rejected for the similar rationale as given above for claims 1 and 32.

Claims 2, 3, 12-14, 33-40, 43-45, 64-71, and 74-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,297,026) Hoffman and (US 5,291,398) Hagan and Carll, Joseph M. —“Should Insurance Agents be offering CDs?”, hereafter Carll in view of (US 4,985,833) Oncken .

1. Claims 2, 33, and 64. Hoffman, Hagan, and Carll failed to disclose, wherein the second portion is used when an investor requests liquidation of funds invested in at least one certificate of deposit at a time before the certificate of deposit matures. Oncken discloses, wherein the second portion is used when an investor requests liquidation of funds invested in at least one certificate of deposit at a time before the certificate of deposit matures (col. 2, lines 10-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Oncken in Hoffman because such an incorporation would allow Hoffman to have the interest rate fixed for the term of the certificate of deposit and to have penalties assessed for early withdrawal.

Claims 3, 34, and 65. Hoffman discloses, further comprising paying, by the processor (Fig. 362), a return to the plurality investors from the financial investment fund (col. 4, lines 30-53).

Claims 4, 35, 66. Hoffman discloses, wherein one of the at least one financial institution manages the financial investment fund (col. 5, line 55-col. 6, line 15).

Claims 5, 36, and 67. Hoffman discloses, wherein the plurality of certificates of deposit have at least one of varying return rates or varying maturity dates (col. 3, lines 1-12).

Claims 6, 37, and 68. Hoffman discloses, wherein the plurality of certificates of deposit include at least one of jumbo certificates of deposit, promissory notes, time deposits, or bonds (col. 2, lines 57-68). Applicant(s) are reminded that as a matter of linguistic precision, optional or conditional elements (e.g. "if," "may," "or", etc.) do not narrow the claims because they can always be omitted. See also MPEP §2106 II C: "Language



that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Claims 7, 38, and 69. Hoffman discloses, wherein the function of the financial institution comprises a credit card operation (col. 2, lines 32-47).

Claims 8, 39, and 70. Hoffman discloses, The method of claim 7, wherein the financial institution uses the first portion to pay merchants for goods or services provided to users of credit cards provided by the financial institution (col. 5, line 33-col. 6, line 15).

Claims 9, 40, and 47. Hoffman, Hagan, and Carll failed to disclose, wherein at least a portion of the plurality of individual funds is insured by the United States federal government. Oncken discloses, wherein at least a portion of the plurality of individual funds is insured by the United States federal government (col. 1, lines 12-56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Oncken in Hoffman because such an incorporation would allow Hoffman to have funds in accounts insured to \$100,000 or more if the amount over \$100,000 is placed in other accounts such as money market, certificates of deposit (cd's) or savings accounts or mutual funds or 401K's or bonds.

Claims 12, 43, and 74. Hoffman discloses, wherein the amount in the transaction account is established to cover no more than an expected amount of the withdrawals from the financial investment fund over a given amount of time (col.2, lines 26-31).

Claims 13, 44, and 75. Hoffman discloses, wherein a yield received by an enterprise managing the financial investment fund on the plurality of financial instruments is

greater than a yield received by the enterprise managing the financial investment fund on funds in the transaction account (col. 5, line 32-col. 6, line 26).

Claims 14, 45, and 76. Hoffman, Hagan, Carll and Oncken failed to disclose, wherein the financial investment fund is used in conjunction with at least one of an individual retirement account or a 401K account. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the financial investment fund used in conjunction with an individual retirement account or a 401K account because this would allow for another means of investment for an individual who is planning for retirement.

Claims 15, 16, 46, 47, 77, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,297,026) Hoffman, (US 5, 291,398) Hagan and Carll, Joseph M. —“Should Insurance Agents be offering CDs?”, hereafter Carll in view of (US 4,985,833) Oncken and further in view of (US 5,987,436) Halbrook.

Claims 15, 46, and 77. Hoffman, Hagan, Carll and Oncken failed to disclose, further comprising providing access to the financial investment fund comprises communicating over a network. Halbrook discloses, wherein providing the financial investment fund via communicating over a network by the processor (col. 3, lines 53-62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Halbrook in Hoffman and Oncken because such an incorporation would allow Hoffman and Oncken to make a deposit and to move investments around in different investments by using a network.

Claim 46. Hoffman, Hagan, Carll, and Oncken failed to disclose, The system of claim 32, further comprising a communicating component that communicates over a network. Halbrook discloses The system of claim 32, further comprising a communicating component that communicates over a network (col. 3, line 53-col. 4, line 3).

Claims 16, 47, and 78. Hoffman, Hagan, Carll and Oncken failed to disclose, wherein user devices on the network are located in at least one of a home, an office, a store, a retail center kiosk, an office of financial institution, or an office of an enterprise managing the financial investment fund. Halbrook did not expressly disclose where his system is located in col. 3, lines 45-62. The method, system, and computer readable medium is performed in the same manner regardless of the location. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ 1031 (Fed. Cir. 1994).

### ***Response to Arguments***

Applicant's arguments filed 3/10/10 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: The Examiner concurred with the amendments to the independent claims, indicating that such amendments would likely make the independent claims 1, 32, and 63 allowable has been considered. Response: There must have been some miscommunication because what was meant was the amended portion to claims 1, 32, and 63 would read over the prior art which did not mean that when a search is performed on the amendment to the claims that the claims would definitely be allowable. When claims are amended and extensive search has to be

performed to make certain there is not any prior art that would still reject the claims.

This is the procedure prior to allowance of an application.

Issue no. 2: Applicants' argue: As acknowledged by the Examiner in the February 22 Examiner Interview non of Hoffman, Hagan, Oncken, or Halbrook disclose or suggest inter alia "wherein the financial investment fund is configured to allow at least one of the plurality of investors to withdraw from the financial investment fund at any time regardless of maturity dates of any of the plurality of certificates of deposit" as recited in independent claim 1 and moreover, the Office Action has cited no factors which would have motivated one of ordinary skill in the art to modify the cited references to achieve Applicants' claimed combination has been considered. Response: Applicants' are arguing the amendment to claim 1 which makes this argument moot.

Issue no. 3: Applicants' argue: Amended independent claims 32 and 63, although different in scope include recitations similar to those of amended claim 1 and accordingly, for at least the same reason as set forth above in connection with amended independent claim 1, Hoffman, Hagan, Oncken, and Halbrook also fail to disclose or suggest the recitations of amended independent claims 32 and 63 has been considered. Response: Applicants' are referred to the responses to arguments in Issue no. 1 and Issue no. 2, Supra.

Comments: claim 1 recites "processor" which can be interpreted as a human being rather than a device. It is suggested that Applicants' add "computer processor" or "server" or "network processor".

Claim 32 recites "a receiving component" which is very broad and varied but does not necessarily mean a device. It is suggest that Applicants" add "server component" or "network component". These suggestions are being made in order to avoid a 35 USC 101 Rejection and preventing the application from being allowed. During patent examination, the pending claims 12-29 and 32-35 must be given the **broadest reasonable interpretation consistent with the specification**. Reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is quite different from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. *In re Prater*, 162 USPQ 541 (CCPA 1969) Resort can be had to case law as follows: "However, the written description is not a substitute for, nor can it be used to rewrite the chosen claim language. Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment. *Resonate Inc. v. Alteon Websystems, Inc.*, 67 USPQ2d 1771 (Fed. Cir. 2003).

"An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...". *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on a Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Trammell James can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3694

June 7, 2010